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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,965	02/04/2004	William Green	GREEN-1	3856

7590 04/20/2006
Connolly Bove Lodge & Hutz LLP
P.O. Box 2207
Wilmington, DE 19899-2207

EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/771,965	Applicant(s) GREEN ET AL.	
	Examiner Mark T. Henderson	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Declaration</u> . |

DETAILED OFFICE ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1 and 20 have been amended for further examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 5, 12, 13, 16, 18, 19, 20, and 27-29 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Henderson's Declaration.

Henderson discloses a declaration of an entertainment card comprising a substrate having a first and an opposite side, a depiction of a person on the first side, a transparent window formed on the substrate at a location which includes a portion (perimeter of buttock shape, legs, torso, face, etc.) of the anatomy of the depicted person; the window creating an absence of the portion from the depicted person, which includes a crease-like area which can be replaced by an end user's digits placed against the window.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-16 and 18-29 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Gardi (2006/0010732).

Gardi discloses in Fig. 1-11, an entertainment card and a method of providing amusement comprising: a greeting card (Fig. 1a) made of stiff shape-retaining cardboard having a first side (or back page, 1, shown in Fig. 1b) and an laminated opposite side (or front page, 4, as shown in

Fig. 1C) a depiction (2) on the first side (1), a transparent window (shown in Fig. 1a), wherein the window creates an absence of a portion (anatomy structure of bear's image) to provide an area which can be replaced by the placement of an end user's digit's through the window in any desired way to create and simulate a 3-D effect of an anatomical area; wherein the card can include printed information (see Fig. 4a and Fig. 7); wherein the absence of the portion being completed at the window independently (through attached shield 3, and end user's digits) of any other portion of the card.

However, Gardi does not disclose: a depiction of a person; wherein the portion is an anatomy of the depicted person; the anatomy is the buttocks, or breast; information about the depicted person; window is at least partially surrounded by clothing on the depicted person; the depicted person is a female or male; wherein the substrate is of a size between a business card and an index card; indicia located on the second side; window is partially surrounded by clothing indicia

In regards to **Claims 1, 3, 4, and 14-16**, it would have been an obvious matter of design choice to make the different portions of the window depiction of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. Therefore, it would have been obvious to make the different portions of window depiction of whatever shape or form as desired, since applicant has not disclosed the criticality of having a particular shape, and

invention would function equally as well with any shape in which a end user's digits can be placed over.

In regards to **Claims 7-11 and 27**, it would have been obvious to one having skill in the art to construct the card in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been to construct the card with any desirable dimension, since applicant has not disclosed the criticality of having a particular size, and invention would function equally as well if constructed in any desirable size.

In regards to **Claims 12, 14 and 26**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any type of desired indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of indicia on the card such as related information or clothing, since applicant has not disclosed the criticality of particular indicia, and the invention would operate equally as well with any type of indicia.

In regards to **Claim 13**, it would have been obvious to place the indicia at any desired location, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the indicia at any desired location since applicant has not disclosed the criticality of having the indicia at a particular location, and would function equally as well at any location.

4. Claim 17 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Gardi in view of Zeisky et al.

Gardi discloses an entertainment card comprising all the elements as claimed in Claim 1, and as set forth above. However, Gardi does not disclose the card having a transparent shield across the window.

Zeisky et al discloses a card having a window cutout (44) with a transparent sheet (46) covering the window (as seen in Fig. 4 and 5)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gardi's card with a transparent shield as taught by Zeisky et al for providing alternative covering over the window.

Response to Arguments

5. Applicant's arguments with respect to claims 12-29 have been considered but are moot in view of the new ground(s) of rejection.

Gardi is now used to disclose a card having a window wherein an end user's digits can be placed over and through the window to simulate an anatomical area.

Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Newell, and Chee disclose similar cards.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

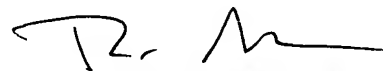
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Boyer Ashley, can be reached at (571) 272-4502. The formal fax number for TC 3700 is (571) 273-8300.



MTH

April 9, 2006



BOYER D. ASHLEY
SUPERVISORY PATENT EXAMINER

Declaration

My name is Mark Henderson, and I am a Patent Examiner in Technology Center 3722 in the United States Patent and Trademark Office. I have been employed by the USPTO since 1998.

All statements made herein based on my knowledge are true, and all statements made on information and belief, are believed to be true.

I had purchased the greeting card set forth in claims 1, 3, 5, 12, 13, 16, 18 and 19 and performed the method with the card as set forth in the claims 20, and 27-29 of the 10/771,965 application filed on February 4, 2004.

I have seen the card and performed the method on the card as set forth in the claims above as early as 1996 and clearly greater than 1 year prior to the filing date of the application.

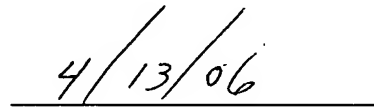
With respect to claims 1, 3, 5, 12, 13, 16, 18, 19, 20, and 27-29, I had purchased a folded two-panel greeting card for a co-worker at a retail store in downtown, Washington, DC. The card had greeting indicia on the front outside and inside surface of the first panel. The card also had indicia on the inside surface of the second panel, wherein a portion of the indicia took the form a person bending over. There was also an aperture in the form of the buttock's perimeter. On the outer surface of the second panel, there were directions to show the end user how to place two

finger digits together, then place both finger digits over and against the aperture on the outer surface of the second panel. As a result when the end user opened the card, the finger digits pressed against the card by the end user took the form of a person's buttocks along with the other greeting indicia. The card is currently not in my possession since it was given away as a gift.

I hereby acknowledge that willful false statements and the like are punishable by fine or imprisonment or both (18 U.S.C. 1001).

A handwritten signature in black ink, appearing to read "Michael Kersh", written over a horizontal line.

Signature

A handwritten date "4/13/06" in black ink, written over a horizontal line.

Date